

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

REMARKS/ARGUMENTS

These remarks are made in response to the final Office Action of March 07, 2005 (Office Action). As this response is filed after the 3-month shortened statutory period along with an appropriate fee and a petition for an extension of time. The present response, filed in response to a final Office Action, includes claim amendments that the Applicants wish to be considered. To insure consideration of these amendments, Applicants have filed the response as an Request for Continued Examination (RCE) to expedite the prosecution process.

In paragraphs 3-4 of the Office Action, the Examiner has rejected claims 7, 12 and 24 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Applicants have amended claims 7 and 12 to omit those limitations that the Examiner found objectionable. Claim 24 has been cancelled. Responsive to the amendments, Applicants respectfully request a withdrawal of the 35 U.S.C. § 112 rejections to claims 7, 12, and 24.

In paragraphs 5-22 of the Office Action, claims 1-6, 18-21 and 23-26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,490,443 to Freeny, Jr., (Freeny) in view of U.S. Patent No. 6,498,180 to Borgstahl, *et al.* (Borgstahl). In paragraphs 23-25, claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Borgstahl in view of U.S. Patent No. 5,968,117 to Schuetze (Schuetze). In paragraphs 26-28, claim 8 has been rejected under 35 U.S.C. § 103(a) as

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

being unpatentable over Freeny and Borgstahl in view of U.S. Patent No. 6,577,720 to Sutter (Sutter). In paragraphs 29-33, claims 9 and 10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeny, Borgstahl and Sutter in view of U.S. Patent Publication No. 2003/0061271 to Pittarelli (Pittarelli). In paragraphs 34-36, claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeny and Borgstahl in further view of Pittarelli. Paragraphs 36-49, the Examiner has rejected claims 12-17, 22, and 27-29 under 35 U.S.C. § 103(a) as being unpatentable over Freeny, in view of Borgstahl, and in further view of Pittarelli.

I. Claim Amendments

In response to the Office Action, claims 1, 12, and 18 have been amended to clarify various disclosed aspects of the present invention. Specifically, claims 1, 12 and 18 have been modified to emphasize that a list of available electronic service provided by the kiosk can be maintained, as supported by page 12, lines 11-15, by page 13, lines 12-13, by page 14, lines 5-13, and by FIG. 4, item 408. Claims 1, 12 and 18 have been amended to specify that a portion of the available services are stored locally within the kiosk and a different portion are retrievable by the kiosk from an ASP, as supported by page 4, lines 13-26. Claims 1, 12 and 18 have also been amended to include the step of receiving a request for electronic services from the wireless device, as supported by page 31, lines 14-15.

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

Claim 12 has been amended to clarify that the kiosk provides the wireless devices with selected ones of the available services for execution in the wireless devices, as supported by page 4, lines 11-13.

No new matter results from these amendments.

II. Overview of Applicants Claimed Invention

Prior to addressing the rejections on the art, a brief review of the Applicants' invention is in order. The Applicants' claimed and disclosed subject matter teaches the retrofitting of an existing kiosk to wirelessly provide electronic services within a personal area network (PAN), thus making the retrofitted kiosk a PAN hub for electronic services. Before retrofitting, the kiosk will not possess wireless communication capabilities, yet will include a physical communication link medium. Many such devices, like payphones, ticket booths, gas station islands, and the like, are physically located in prime locations to permit them to function as PAN hubs. Further, these existing kiosk are visibly identifiable to potential users, so that users can easily identify locations where wireless communications are available. The location of the retrofitted kiosk in visibly identified and highly trafficked locations is significant, as competition for wireless access points at key locations in highly trafficked areas is currently high. Additionally, users need to be aware of the locations of access points to effectively utilize them. Visible retrofitted kiosks are ideal in that consumers can quickly identify such kiosks (such as payphones provided by a particular carrier or gas station islands for a particular gas

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

station chain) and will rapidly associate the retrofitted kiosks with the new wireless service.

It should be emphasized that the retrofitted kiosks are configured to provide electronic services on demand. Towards this end, a data store local to the kiosk can be used to store commonly requested electronic services. When a wireless device requests one of these service, the retrofitted kiosk can provide it immediately over a wireless data link (page 4, lines 14-18). When a requested service is not locally stored within the kiosk, the service can be downloaded from a remote source using the existing physical communications link, and thereafter wirelessly delivered to the requesting wireless device (page 4, lines 20-22). The electronic services once delivered can be locally executed upon the wireless device even when the wireless device is no longer connected to the PAN. In consequence, the electronic services can be delivered to a wide variety and quantity of electronic devices without consuming substantial system resources and network bandwidth (page 3, lines 6-8).

III. Freeny and Borgstahl in Combination Fail to Teach each Claimed Limitation

Claims 1-6, 18-21 and 23-26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeny in view of Borgstahl.

A. Overview of Freeny

Freeny teaches the utilization of kiosk units as a communication bridge that enables multiple wireless devices using multiple protocols to access a

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

telecommunications backbone. Freeny teaches the bridge (50) can be a retrofitted public telephone. Using reference numbers from FIG. 1, the bridge (50) enables the multiple wireless device 40 to link public communication switches (20) in order to establish real-time communications with requested parties (30). Additionally from FIG. 2, Freeny teaches that the bridge (50) can include a micropayment (220) unit for accepting payment for the bridging/ telecommunications session from the wireless device.

B. Overview of Borgstahl

Borgstahl discloses that a mobile telephone or other such device can be used as a personal presence identifier 122. The personal presence identifier 122 can store a user's identity for authorization purposes and can store the user's desktop configuration settings and personalization data so that the settings can be transferred to proximately located computers, as noted by column 11 line 63 to column 12, line 17. The proximately located computers having more robust I/O peripherals than the mobile telephone can then be used in a user-centric fashion. Thus, Borgstahl ameliorates problems associated with I/O inadequacies of mobile telephones or other such devices, as noted by column 1, lines 30-34. Borgstahl's stated purpose is to personalize the computing environments about a user, using the personal presence identifier, as noted by column 13, line 61 to column 14, line 44.

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

C. No Proper Motivation to Combine Freeny and Borgstahl Exists

Freeny teaches a communication bridge for establishing live communications between a wireless device user and a recipient linked to a telecommunication backbone. Freeny's architecture requires that multiple communication channels exist within the bridge (kiosk). Each of these channels are channels that can be utilized for a live telecommunications session (between the wireless device, the bridge, and/or the public telecom switch). The intent and purpose of Freeny is to establish a short wireless communication path to a telecommunication backbone to enable live communications between a wireless device user and a remotely located telephone user.

Borgstahl describes a wireless communication device that functions as a mobile presence identifier so that kiosks can "react" to a user, when the user is proximate to the kiosk. Applicants believe that a combination of Freeny and Borgstahl would be proper for purposes of enabling the micro payment portion of Freeny. Modifying Freeny to provide electronic services (claimed) to a device instead of to bridge a device user into a telecommunication backbone is unsupported by the purpose and architecture of Freeny.

Any modification of Freeny that results in Freeny not linking a user to telecommunication backbone for purposes of establishing a telecommunication session with a requested party linked to the backbone is not supported by Freeny. That is, such a modification would render Freeny unsatisfactory for its intended purpose, which is

Appl. No. 09/803,256

RCB dated July 07, 2005

Reply to Office action of Mar. 07, 2005

Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

explicitly not permitted (by MPEP 2143.01) when combining references to reject claims under § 103.

Further, Freeny details a solution where a wireless device can be utilized when in range of the bridge (kiosk). The same is true for the kiosk of Borgstahl. In contrast, the Applicants' claimed invention conveys electronic services to a wireless device, when the device is in range of a kiosk, the provided electronic services once provided to the wireless device can be used at any time by the user, whether the electronic device is within the range of the wireless network centered on the kiosk or not. Accordingly, Freeny and Borgstahl (teaching kiosk proximate functionality only) are being modified in a manner to operate in a kiosk independent manner. Such a modification is against explicit teachings (bridging into a telecom infrastructure of Freeny; and modifying a localize environment <kiosk behavior> based upon identifying information from a mobile device of Borgstahl). Such a modification is improper as being unsupported by the cited references.

D. Neither Freeny, Borgstahl, nor Combinations thereof Teach Maintaining a List of Available Electronic Services Provided by the Kiosk

Freeny does not provide electronic services from a kiosk, but instead functions as a bridge to an wireless device into a telecommunications backbone. Further, providing a "list" of services makes no sense in terms of Freeny since the only "service" provided is the "service" of linking a wireless caller to a telecommunication backbone. It should be

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

noted that such as "service" is not an electronic service as defined in the Applicants claims.

Borgstahl fails to cure this deficiency of Freeny.

E. Neither Freeny, Borgstahl, nor Combinations thereof Teach that a Kiosk Provides Locally Stored and Remotely Located Services

Freeny does not provide electronic services from a kiosk, but instead functions as a bridge to an wireless device into a telecommunications backbone. Further, storing local services makes no sense in terms of Freeny since the only "service" provided is the "service" of linking a wireless caller to a telecommunication backbone. Accordingly, Freeny lacks teachings that a kiosk provides both locally stored services and remotely stored services.

Borgstahl fails to cure this deficiency of Freeny.

F. Neither Freeny, Borgstahl, nor Combinations thereof Teach Receiving a request for Available Electronic Services from a Wireless Device

In both Freeny and Borgstahl, the wireless device is not used to request services from a kiosk. Neither Freeny nor Borgstahl alone nor in combination teach the claimed limitation of receiving a request for available electronic services and then delivering only the requested ones of the available services to the wireless device.

In light of the above, Applicants respectfully request that the rejections to claims 1-6, 18-21 and 23-26 based upon Freeny in view of Borgstahl be withdrawn.

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

IV. The Deficiencies of Freeny and Borgstahl are not cured by Schuetze

In paragraphs 23-25, claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeny and Borgstahl in view of Schuetze.

Schuetze discloses a device and system for accessing electronic mail from a remote interface. Schuetze fails to provide teachings regarding kiosks and/or wireless communications involving kiosks. More specifically, Schuetze fails to teach that a list of services is maintained within kiosk, that services provided by a kiosk can be locally stored or acquired from a remote source, and that a wireless device is able to select service that are to be delivered via the kiosk.

Because each claimed limitation of claim 7 is not expressly or implicitly taught by combinations of Freeny, Borgstahl, and Schuetze, the rejection to claim 7 should be withdrawn, which action is respectfully requested.

V. The Deficiencies of Freeny and Borgstahl are not cured by Sutter

Claim 8 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeny and Borgstahl in view of Sutter.

Sutter discloses a system and method for providing high-speed communications from a public terminal, such as a payphone. The public terminal has a first interface that allows a user to communicate with a switched communications network and a second interface that connects a device to a high-speed communication network, where the second interface is activated via a user interactive communication through the first

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

interface, as noted by claim 1. One purpose of Sutter is to utilize a similar billing infrastructure for a high-speed communication port as that used by the switched communications network interface, as noted by column 1, lines 52-55. Another purpose of Sutter is to enable users to maintain both voice and data communication paths during a single session, as noted by column 1, lines 57-60.

Sutter fails to teach that a list of services is maintained within a kiosk, that services provided by a kiosk can be locally stored or acquired from a remote source, and that a wireless device is able to select service that are to be delivered via the kiosk.

Because each claimed limitation of claim 8 is not expressly or implicitly taught by combinations of Freeny, Borgstahl, and Sutter, the rejection to claim 8 should be withdrawn, which action is respectfully requested.

VI. The Deficiencies of Freeny and Borgstahl and Sutter are not cured by Pittarelli

Claims 9 and 10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeny, Borgstahl and Sutter in view of Pittarelli. Claims 11-17, 22, and 27-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeny and Borgstahl in view of Pittarelli.

Pittarelli teaches an architecture for establishing communications between a plurality of kiosks using a central station. Pittarelli is silent in regard to establishing communications between the kiosks and remote user devices. Pittarelli is silent regarding retrofitting existing kiosks.

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

Pittarelli fails to teach that a list of services is maintained within kiosk, that services provided by a kiosk can be locally stored or acquired from a remote source, and that a wireless device is able to select service that are to be delivered via the kiosk.

Because each claimed limitation of claims 9 and 10 is not expressly or implicitly taught by combinations of Freeny, Borgstahl, Sutter, and Pittarelli, the rejection to claims 9-17, 22, and 27-29 should be withdrawn, which action is respectfully requested.

VII. Conclusion

Applicants have shown that combinations of Freeny, Borgstahl, Schuetze, Sutter, and Pittarelli fail to teach each claimed limitation of the present invention.

Even though the claimed limitations of the present invention are not taught by the above references, Applicants note that an additional reason that the claims are currently in an allowable state is that no proper motivation exists to combine the references in the manner attempted. That is, Applicants re-assert their previously presented argument (Reply of November, 12, 2004) detailing why it was improper to combine the references of Borgstahl, Sutter, and Pittarelli for purposes of 35 U.S.C. § 103. For the same reasons, it is also improper to combine the Freeny and Schuetze references with Borgstahl, Sutter, and Pittarelli for purposes of the claimed invention.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the

Appl. No. 09/803,256
RCE dated July 07, 2005
Reply to Office action of Mar. 07, 2005
Docket No. 6169-181

IBM Docket No. BOC9-2000-0040

Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date:

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